

REMARKS

I. Prosecution History

Claims 1-13 were presented for examination by Applicant's filing of a nonprovisional application on January 16, 2004. Under the first non-final Office Action, dated October 4, 2007, claims 1-13 were rejected under 35 U.S.C. 102(e) as being anticipated by Murren et al (US Pub No 2003/0110085). Applicant amended claims 1, 6, 12 and 13 and requested reconsideration of the application.

Under the current final Office Action, claims 1-13 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (2002/0007374). Applicant has responded in a timely manner to these rejections and now respectfully requests an Advisory Action pursuant to MPEP 706.07(f).

II. Claim Rejections – 35 U.S.C. §103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection), an applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992). Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

Murren in view of Marks

Claims 1-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (US Pub No. 2002/0007374).

Regarding claim 1, the Examiner argues that Murren discloses maintaining synchronization of information published to multiple subscribers, comprising: publishing document library subject availability via multicast communication over a data network; receiving subscriptions for document library subjects via point-to-point data communication over the data network from remote subscribers at individual sites; and instantaneously, at time of repository change, synchronizing data representative of the document with remote subscribers at individual sites over the data network. The Examiner further argues that though Murren fails to teach a data network using a multicast communication transport layer, this is well known in the art as evidenced by Marks. The Examiner states that Marks discloses a data network using a multicast communication transport layer. The Examiner argues, that in view of Marks, it would have been obvious to one of ordinary skill at the time of the invention was made to have the feature of a data network using a multicast communication transport layer in order to have a one-to-many transmission protocol.

Applicant respectfully disagrees with this assessment and submits that the Examiner has failed to meet the three prongs of the *prima facie* case of obviousness with respect to claim 1. Regarding the third prong, Murren does not disclose a method of instantaneously, at the time of repository change, synchronizing with remote subscribers. There is no mention in Murren of a timeframe for when the publishing component publishes updated information to subscribers, while in the

Applicant's invention the instantaneous synchronization is essential to reducing network bottlenecks in transmitting data. Therefore, Murren does not disclose all of the limitations of Applicant's claim 1 and the assessment fails the third prong of the aforementioned *prima facie* case of obviousness.

With respect to the second prong, the Examiner has not provided any evidence that one of ordinary skill in the art would be successful in combining Murren with Marks to achieve all of the features and limitations of Applicant's claim 1.

With respect to the first prong, the Examiner has not provided any evidence of a suggestion, either within the references themselves or in the general knowledge at the time the invention was made, or motivation for one of ordinary skill in the art to combine Murren with Marks. The Applicant reminds the Examiner that the references may not be taken out of context and combined without motivation, in effect producing the words of the claims (and sometimes, not even the words or concepts of the claims), without their meaning or context. The resultant combination would not yield the invention as claimed. Claim 1 is rejected under 35 U.S.C. 103 and no showing has been made to provide the motivation as to why one of skill in the art would be motivated to make such a combination, and further fails to provide the teachings necessary to fill the gaps in these references in order to yield the invention as claimed. Therefore, the Applicant respectfully requests a withdrawal of the rejection to claim 1.

Regarding claim 2, the Examiner argues that the Murren discloses the method of claim 1 wherein jobs are assigned to subjects. The Applicant respectfully disagrees with this assessment and submits that the arguments made above against the rejection of claim 1 apply equally to the rejection of claim 2. Therefore, because the rejection to claim 2 fails under the three requirements for *prima facie* obviousness, the Applicant respectfully requests withdrawal of the rejection to claim 2.

Regarding claim 3, the Examiner argues that Murren discloses the method of claim 2 wherein said jobs include documents. The Applicant respectfully disagrees with this assessment and submits that the arguments made above against the rejection of claim 1 apply equally to the rejection of claim 3. Therefore, because the

rejection to claim 3 fails under the three requirements for *prima facie* obviousness, the Applicant respectfully requests withdrawal of the rejection to claim 3.

Regarding claim 4, the Examiner argues that Murren discloses the method of claim 3 wherein said jobs are documents. The Applicant respectfully disagrees with this assessment and submits that the arguments made above against the rejection of claim 1 apply equally to the rejection of claim 4. Therefore, because the rejection to claim 4 fails under the three requirements for *prima facie* obviousness, the Applicant respectfully requests withdrawal of the rejection to claim 4.

Regarding claim 5, the Examiner argues that Murren discloses the method of claim 1, wherein remote subscribers at individual sites interested in a subject can subscribe to the subject and receive document updates automatically, wherein only necessary data related to the subject is synchronized with the remote subscribers at specific sites. The Applicant respectfully disagrees with this assessment and submits that the arguments made above against the rejection of claim 1 apply equally to the rejection of claim 5. Therefore, because the rejection to claim 5 fails under the three requirements for *prima facie* obviousness, the Applicant respectfully requests withdrawal of the rejection to claim 5.

Regarding claim 6, the Examiner argues that Murren discloses maintaining synchronization of information published to multiple subscribers, comprising: publishing document library subject availability via multicast communication over data network and receiving subscriptions for document library subjects over the data network via point-to-point data communication from remote subscribers at individual sites. Further regarding claim 6, the Examiner argues that though Murren fails to teach a data network using a multicast communication transport layer, this is well known in the art as evidenced by Marks. The Examiner argues that Marks discloses a data network using a multicast communication transport layer, therefore, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a data network using a multicast communication transport layer in order to have a one-to-many transmission protocol.

The Applicant respectfully disagrees with this assessment and submits that claim 6 has been amended to include "instantaneously synchronizing data

representative of the document with remote subscribers at individual sites over the data network using a multicast communication transport layer". Applicant respectfully submits that the Examiner has failed to meet the three prongs of the *prima facie* case of obviousness for claim 6. With respect to the third prong, Murren does not disclose a method of instantaneously synchronizing data representative of the document with remote subscribers. There is no mention in Murren of a timeframe for when the publishing component publishes updated information to subscribers, while in the Applicant's invention instantaneous synchronization is essential to reducing network bottlenecks in transmitting data. Therefore Murren does not disclose all of the limitations of Applicant's claim 6 and the assessment fails the third prong of the aforementioned *prima facie* case of obviousness.

With respect to the second prong, the Examiner has not provided any evidence that one of ordinary skill in the art would be successful in combining Murren with Marks to achieve all of the features and limitations of Applicant's claim 6.

With respect to the first prong, the Examiner has not provided any evidence of a suggestion, either within the references themselves or in the general knowledge at the time the invention was made, or motivation for one of ordinary skill in the art to combine Murren with Marks. The Applicant reminds the Examiner that the references may not be taken out of context and combined without motivation, in effect producing the words of the claims (and sometimes, not even the words or concepts of the claims), without their meaning or context. The resultant combination would not yield the invention as claimed. Claim 6 is rejected under 35 U.S.C. 103 and no showing has been made to provide the motivation as to why one of skill in the art would be motivated to make such a combination, and further fails to provide the teachings necessary to fill the gaps in these references in order to yield the invention as claimed. Therefore, the Applicant respectfully requests withdrawal of the rejection to claim 6.

Regarding claim 7, the Examiner argues that Murren discloses the method of claim 6 further comprising instantaneously synchronizing data representative of the document with remote subscribers at individual sites over the data network. Further regarding claim 7, the Examiner argues that though Murren fails to teach the data

network using a multicast communication transport layer, this is well known in the art as evidenced by Marks. The Examiner argues that Marks discloses the data network using a multicast communication transport layer, therefore, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of the data network using a multicast communication transport layer in order to have a one-to-many transmission protocol. The Applicant respectfully submits that claim 7 has been cancelled, thus rendering this rejection moot.

Regarding claim 8, the Examiner argues that Murren discloses the method of claim 7 wherein jobs are assigned to subjects. The Applicant respectfully submits that claim 8 has been cancelled, thus rendering this rejection moot.

Regarding claim 9, the Examiner argues that Murren discloses the method of claim 8 wherein said jobs include documents. The Applicant respectfully disagrees with this assessment and submits that claim 9 has been amended to depend on claim 6 in light of claim 8 being cancelled. The Applicant submits that the arguments made above against the rejection to claim 6 apply equally to claim 9. Therefore, because the rejection to claim 9 fails under the requirements of *prima facie* obviousness, the Applicant respectfully requests a withdrawal of the rejection to claim 9.

Regarding claim 10, the Examiner argues that Murren discloses the method of claim 8 wherein said jobs are documents. The Applicant respectfully disagrees with this assessment and submits that claim 10 has been amended to depend on claim 6 in light of claim 8 being cancelled. The Applicant submits that the arguments made above against the rejection to claim 6 apply equally to claim 10. Therefore, because the rejection to claim 10 fails under the requirements of *prima facie* obviousness, the Applicant respectfully requests a withdrawal of the rejection to claim 10.

Regarding claim 11, the Examiner argues that Murren discloses the method of claim 7, wherein subscribers at individual sites interested in a subject can subscribe to the subject and receive document updates automatically and wherein only necessary data related to the subject is synchronized with the remote subscribers at specific sites. The Applicant respectfully disagrees with this assessment and submits that claim 11 has been amended to depend on claim 6 in

light of claim 7 being cancelled. The Applicant submits that the arguments made above against the rejection to claim 6 apply equally to claim 11. Therefore, because the rejection to claim 11 fails under the requirements of *prima facie* obviousness, the Applicant respectfully requests a withdrawal of the rejection to claim 11.

Regarding claim 12, the Examiner argues that Murren discloses maintaining synchronization of information published to multiple subscribers, comprising: at least one server having access to a data network supporting point-to-point data communication; at least one database containing documents associated with a print ready document library and the print ready document library; software contained in at least one server; and software for managing the publication of print ready document library information to multiple subscribers over the data network, accepting document library subscription from the multiple subscribers point-to-point data communication, and synchronization of print ready document library and documents associated with the library with the multiple subscribers from the database through the server and the network point-to-point data communication to multiple subscriber equipment.

Further regarding claim 12, the Examiner states that though Murren fails to teach a data network also supporting multicasting over a multicast communication transport layer and using a multicast communication layer, this is well known in the art as evidenced by Marks. The Examiner argues that Marks discloses a data network also supporting multicasting over a multicast communication transport layer, therefore, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a data network also supporting multicasting over a multicast communication transport layer and a data network using a multicast communication transport layer in order to have a one-to-many transmission protocol.

Applicant respectfully disagrees with this assessment and submits that the Examiner has failed to meet the three prongs of the *prima facie* case of obviousness for claim 12 in light of claim 12 being amended to include "instantaneous" synchronization. With respect to the third prong, Murren does not disclose a system of instantaneous synchronization with multiple subscribers. There is no mention in Murren of a timeframe for when the publishing component publishes updated

information to subscribers, while in the Applicant's invention the instantaneous synchronization is essential to reducing network bottlenecks in transmitting data. Therefore, Murren does not disclose all of the limitations of Applicant's claim 12 and the assessment fails the third prong of the aforementioned *prima facie* case of obviousness.

With respect to the second prong, the Examiner has not provided any evidence that one of ordinary skill in the art would be successful in combining Murren with Marks to achieve all of the features and limitations of Applicant's claim 12.

With respect to the first prong, the Examiner has not provided any evidence of a suggestion, either within the references themselves or in the general knowledge at the time the invention was made, or motivation for one of ordinary skill in the art to combine Murren with Marks. The Applicant reminds the Examiner that the references may not be taken out of context and combined without motivation, in effect producing the words of the claims (and sometimes, not even the words or concepts of the claims), without their meaning or context. The resultant combination would not yield the invention as claimed. Claim 12 is rejected under 35 U.S.C. 103 and no showing has been made to provide the motivation as to why one of skill in the art would be motivated to make such a combination, and further fails to provide the teachings necessary to fill the gaps in these references in order to yield the invention as claimed. Therefore, the Applicant respectfully requests a withdrawal of the rejection to claim 12.

Regarding claim 13, Murren discloses the system of claim 12, further comprising communication equipment associated with the server for enabling multicast communication with the multiple subscribers over the data network. The Applicant respectfully disagrees with this assessment and submits that the arguments made above against the rejection to claim 12 apply equally to claim 13. Therefore, the Applicant respectfully requests a withdrawal of the reject to claim 13.

III. Conclusion

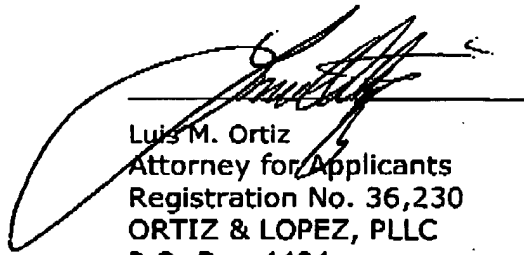
In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention and now respectfully request the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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